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10/711,827	10/07/2004	Christopher John Fletcher	70655.4800	5826
66170 7590 04/16/2008 AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC. c/o SNELL & WILMER, L.L.P. ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER TAYLOR, APRIL ALICIA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary**Application No.**

10/711,827

Applicant(s)FLETCHER, CHRISTOPHER
JOHN**Examiner**

APRIL A. TAYLOR

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Preliminary Amendment filed July 22, 2005.
2. Receipt is acknowledged of the Amendment filed January 10, 2008. Claims 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 are pending in the application.

Claim Objections

3. Claims 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 are objected to because of the following informalities:

Re claim 1: Substitute "at least one of the primary account" with -- the primary account -- (see line 23).

Re claim 13: Substitute "the primary account PIN number " with -- the primary account number -- (see line 3).

Re claim 17: Substitute "the primary account PIN number " with -- the primary account number -- (see line 7).

Re claim 19: Substitute "said at least one primary account" with -- said primary account -- (see line 11).

Re claim 25: Substitute "said at least one primary account" with -- said primary account -- (see line 23).

Re claim 32: Substitute "said at least one primary account" with -- said primary account -- (see line 23).

Appropriate correction is required.

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2, which is dependent upon claim 1, recites "wherein the step of issuing the limited use PIN to a first party to facilitate a transaction with a second party comprises configuring the limited use PIN to be immediately usable for facilitating the transaction". This particular method step is performed in claim 1. Therefore, claim 2 does not further limit the subject matter of claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment now recites "receiving transaction information from (claim 1) or providing transaction information to (claim 19) the second party (merchant) for

authorization, wherein the transaction information includes the account number and limited use PIN" which is not supported in the specification. The specification describes the step of receiving transaction information from the second party (merchant) for authorization, wherein the transaction information includes the limited use PIN. According to the specification, the system prevents the user's primary account number from being passed to the merchant in order to prevent compromising the primary account number for fraudulent use. However, the examiner was unable to locate in the specification the specific teachings of receiving or providing both the account number and PIN number from or to the second party (merchant).
(Note: Claims 2-7, 11-14, 16, 17, 22, 23, 25, 26, 28-30 and 32 are rejected to since they are dependent upon a rejected claim)

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7, 11-14, 16 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14, 16 and 17 of copending Application No. 11/777,396 (hereinafter '396). Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present claimed invention and the '396 application discloses the same subject matter. For example, in claim 1 of the present claimed invention and claims 1 and 2 of the '396 application, the Applicant claim:

- identifying at least one primary account;
- generating a limited use PIN that is configured to facilitate a transaction;
- associating the limited use PIN with said at least one primary account;
- issuing the limited use PIN to a first party to facilitate a transaction with a second party, wherein the limited use PIN is configured to be immediately usable for facilitating the transaction with the second party;
- receiving transaction information from the second party for authorization;
- forwarding the transaction information to a card authorization system for authorization processing;
- processing the transaction information with the card authorization system,

wherein the card authorization system determines whether the transaction information includes the limited use PIN and interfaces with a limited use PIN system to determine whether authorization is appropriate, wherein the authorization determination includes:

receiving account information that is associated with the limited use PIN;
determining whether conditions of use associated with the limited us PIN
are satisfied, the conditions of use parameters defining at least a predetermined
restriction on use of the limited use PIN;
returning an appropriate approval code to the second party, when conditions of
use parameters associated with the limited use PIN and the primary account are
satisfied; and
declining the authorization request when either the conditions associated with the
primary account and the limited use PIN are not satisfied. (See claims 1 and 2 in the
papers filed 1/23/08 of the '396 application)

As to claims 2-7, 11-14, 16 and 17 of the present claimed invention, the '396
application meets all the limitation as set forth in claims 3-14, 16 and 17.

This is a provisional obviousness-type double patenting rejection because the
conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

10. Claims 1-7, 11-14, 16, 17, 19, 22, 23, 25, 26, 28-30 and 32 are rejected under 35
U.S.C. 102(b) as being anticipated by Armes (US 2001/0034720 A1).

Re claims 1 and 2: Arnes teaches a system and method for facilitating a transaction comprising:

identifying at least one primary account (PCC 20) (see paragraph 0053);
generating a limited use PIN (STN 15) that is configured to facilitate a transaction (see paragraphs 0048 and 0053);

associating the limited use PIN with said at least one primary account (see paragraph 0053);

issuing the limited use PIN to a first party (1) to facilitate a transaction with a second party (2), wherein the limited use PIN is configured to be immediately usable for facilitating the transaction with the second party (see paragraphs 0048 and 0055);

receiving transaction information from the second party for authorization (see paragraph 0085);

forwarding the transaction information to a card authorization system (7) for authorization processing (see paragraph 0085);

processing the transaction information with the card authorization system (7), wherein the card authorization system (7) determines whether the transaction information includes the limited use PIN and interfaces with a limited use PIN system to determine whether authorization is appropriate (see paragraph 0085), wherein the authorization determination includes:

receiving account information that is associated with the limited use PIN (see paragraph 0085);

determining whether conditions of use associated with the limited use PIN are satisfied, the conditions of use parameters defining at least a predetermined restriction on use of the limited use PIN (see paragraphs 0056 and 0085); returning an appropriate approval code to the second party, when conditions of use parameters associated with the limited use PIN and the primary account are satisfied (see paragraph 0086); and

declining the authorization request when either the conditions associated with the primary account and the limited use PIN are not satisfied (see paragraph 0086).

Re claims 3 and 4: Arnes further teaches allowing the first party to select and define conditions-of-use parameters, wherein the parameters place limits on how the limited use PIN may be used; and associating the conditions-of-use parameters with the limited use PIN (see paragraphs 0048 and 0056).

Re claim 5: Arnes teaches storing the condition of use parameters in one or more account database fields (172) associated with the limited use PIN (see paragraph 0059).

Re claim 6: Arnes teaches wherein the steps of selecting and defining the conditions of use parameters comprise selecting and defining at least one of: a limited use PIN credit limit, limiting use of a limited use PIN on account balance availability, a limited use PIN expiration date, a predetermined number of transactions before the limited use PIN is declined, limiting use of a limited use PIN to a specified dollar amount per transaction, limiting use of a limited use PIN to a total dollar amount for pre-designated number of transactions, whether a limited use PIN can be used to earn

loyalty points, whether a limited use PIN can be used to redeem loyalty points, limiting use of a limited use PIN to a maximum dollar amount per month, use of a limited use PIN for a specified merchant only, restricting use of a limited use PIN to a specified user, and specifying that all online transactions be performed using only a limited use PIN. (See paragraphs 0056-0057)

Re claim 7: Armes teaches wherein the conditions of use parameters comprise a notification response, wherein the notification response includes notifying a third party (92) whenever the limited use PIN is used. (See figures 8 and 11; and paragraph 0087)

Re claim 11: Armes teaches wherein the steps of determining when conditions of use associated with the primary account and limited use PIN are satisfied, comprises determining when at least one of the following conditions of use are satisfied: a limited use PIN credit limit, a limited use PIN account balance availability, a limited use PIN expiration date, a predetermined number of transactions before the limited use PIN is declined, limiting the use of a limited use PIN to a specified dollar amount per transaction, limiting the use of a limited use PIN to a total dollar amount for pre-designated number of transactions, whether a limited use PIN can be used to earn loyalty points, whether a limited use PIN can be used to redeem loyalty points, limiting the use of a limited use PIN to a maximum dollar amount per month, use of a limited use PIN for a specified merchant only, restricting use of a limited use PIN to a specified user, and specifying that all online transactions be performed using only a limited use PIN. (See paragraph 0056-0057 and 0085)

Re claim 12: Armes further teaches:

receiving transaction settlement information from a the second party, wherein the transaction was facilitated using the limited use PIN (see paragraph 0091);

identifying the transaction settlement information as a transaction involving the limited use PIN (see paragraph 0091);

verifying that the limited use PIN is a valid number (see paragraph 0091);

capturing the transaction settlement information in a financial capture system (10) (see paragraph 0091); and

causing the second party to be paid (see paragraph 0091).

Re claim 13: Armes further teaches: identifying the primary account that is associated with the limited use PIN; replacing the limited use PIN with the primary account number; processing the transaction settlement information in an accounts receivable system; and generating a billing statement that includes at least the primary account number. (see paragraphs 0091-0092)

Re claim 14: Armes further teaches the steps of comparing the transaction settlement information with conditions of use parameters associated with the limited use PIN to determine when the conditions of use have been satisfied (see paragraph 0086).

Re claim 16: Armes the step of receiving from the second party a settlement request for payment of a transaction involving the limited use PIN, wherein the second party is paid when the limited use PIN is valid (see paragraphs 0086 and 0091).

Re claim 17: Armes teaches the steps of:

routing the second party settlement request for payment to a financial capture system (10) (see paragraph 0091);

creating an accounts payable file and routing the accounts payable file to an accounts payable system (9) for payment processing (see paragraph 0091); and

creating an accounts receivable file and routing the accounts receivable file to a service that retrieves the associated primary account number and replaces the limited use PIN with the primary account number and forwards the resulting accounts receivable file to an accounts receivable system to generate the first party billing statement (see paragraphs 0091-0092).

Re claims 19 and 22: Armes a method for facilitating a transaction comprising the steps of:

registering with a card provider (3) to use a transaction system (see paragraphs 0064-0065);

logging-in to the card provider's transaction system by providing authenticating information, and causing card provider to verify that a first party (1) is a registered and authorized user (see paragraphs 0064-0065, 0068);

designating a transaction account as a primary account, wherein the primary account is a non-currency based account (see paragraph 0066);

requesting a limited use PIN from the card provider (3), causing the card provider to generate a limited use PIN and to associate the limited use PIN with the previously selected said primary account (see paragraphs 0058-0059);

receiving the limited use PIN from the card provider (see paragraphs 0058-0059);

providing the limited use PIN to a second party (2) to facilitate a transaction (see paragraph 0051);

selecting conditions of use parameters to be associated with the limited use PIN (see paragraphs 0058-0059); and

defining conditions of use parameters to be associated with the limited use PIN (see paragraphs 0058-0059).

Re claim 23: Armes teaches wherein the steps occur online (see paragraphs 0064-0065).

Re claim 25: Armes teaches wherein the primary account is associated with an electronic line of credit system (see paragraphs 0053 and 0066).

Re claim 26: Armes teaches disputing a charge for a transaction involving a limited use PIN, and causing the card provider (3) to charge back the charge to the second party (2) (see paragraphs 0093-0094).

Re claim 28: Armes teaches the steps of:

receiving a primary account number from the first party to initiate a transaction (see paragraphs 0066 and 0068);

sending the primary account number to a card provider during a card authorization process, requesting that the card provider generate and return a limited use PIN that is associated with the primary account number (see paragraphs 0066 and 0068); and

receiving from the card provider the limited use PIN associated with the primary account, wherein the limited use PIN is then used to facilitate a transaction settlement (see paragraphs 0066 and 0068).

Re claim 29: Armes teaches:

receiving a primary account number from a first party (1) to initiate a transaction (see paragraphs 0066 and 0068);

sending the primary account number to a card provider, requesting that the card provider generate and return the limited use PIN that is associated with the primary account number (see paragraphs 0066 and 0068);

receiving from the card provider the limited use PIN associated with the primary account, wherein the limited use PIN is then used to facilitate a transaction settlement (see paragraphs 0066 and 0068); and

purging the primary account number from the second party's records and replacing with the associated limited use PIN (see paragraph 0100).

Re claim 30: Armes teaches wherein the step of generating the limited use PIN comprises:

receiving a primary account number from a first party (1) to initiate a transaction (see paragraphs 0066 and 0068);

sending the primary account number to a card provider, requesting that the card provider generate and return information that is associated with the primary account number (see paragraphs 0066 and 0068);

receiving from the card provider (3) information associated with the primary account, wherein the information is then used to facilitate a transaction settlement (see paragraphs 0066 and 0068); and

purging the primary account number from the second party's records and replacing with the associated information (see paragraph 0100).

Re claim 32: Armes teaches wherein the primary account is a line of credit account (see paragraph 0066).

Response to Arguments

11. Applicant's arguments filed January 10, 2008 have been fully considered but they are not persuasive. The applicant argues that the secure transaction number as taught by Armes is different from the limited use personal identification number (PIN) recited in the claims due to the number of digits of the secure transaction number. The applicant also argues that the secure transaction number can be easily compromised since the length of the number will make it difficult for a person to retain within their memory thus, requiring the secure transaction number to be written or printed on some type of medium. The examiner respectfully disagrees. The examiner believes that the personal identification number, as recited in the claims, is not limited to a four digit number. One of ordinary skill in the art would recognize that a personal identification number can be number of any length. According to paragraph 0047 of the applicant specification, the limited use PIN can be a four or more digit number. Therefore, the examiner believes that the secure transaction number serves the same function as a personal identification number (PIN). Furthermore, the examiner believes that the secure transaction number can be easily memorized dependent upon the user requesting the limited use secure transaction number.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **APRIL A. TAYLOR** whose telephone number is (571)272-2403. The examiner can normally be reached on Monday - Friday from 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven S. Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used

by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/STEVEN S. PAIK/
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AAT
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